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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/747,616

12/30/2003

Kothapalli Venkata Raju

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WOMBLE CARLYLE SANDRIDGE & RICE, PLLC

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EXAMINER

CHEN, VIVIAN

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/747,616	<b>Applicant(s)</b> RAJU ET AL.	
	<b>Examiner</b> Vivian Chen	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4 and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4 and 21-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

1. Claims 3, 5-20 have been cancelled by Applicant

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/16/2007 has been entered.

***Specification***

2. The amendment filed 10/27/2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the omission of the NILSET™ 117, HAPCO™ NXZ, and BORCHI® GOI E2 from the recited coating composition. The disclosure as originally filed appears to require the presence of the above three components in the formulations I and II (see published application paragraph 0028-0029) and therefore does not provide support for coating compositions of type I or II which do not contain the said three omitted components.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-2, 4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention in objection under U.S.C. 132(a) to the amendment filed 10/27/2006. The disclosure as originally filed appears to require the presence of the above three components in the coating composition formulations I and II (see published application paragraph 0028-0029), and therefore does not provide support for coating compositions of type I and II which do NOT contain the said three omitted components.

***Claim Rejections - 35 USC § 103***

5. Claims 1-2, 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over:

KYMINAS ET AL (US 4,749,731),

in view of KADAMBANDE ET AL (US 6,627,700) or WEINMANN ET AL (US 6,395,845).

KYMINAS ET AL discloses a surface coating composition comprising a weather-resistant polymeric binder and a pigment content of 20-60 wt%, wherein the coating composition

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typically contain 3-25 wt% titanium dioxide, 5-30 wt% talc, and 1-25 wt% calcined clay. (line 50-62, col. 4; line 45-66, col. 5; line 25-38, col. 6) However, the reference does not explicitly recite an alkyd or epoxy binder resin binder.

KADAMBANDE ET AL discloses that it is well known in the art to use acrylate-modified alkyd resins as binders for pigment-containing coatings suitable for exterior and structural applications. (KADAMBANDE ET AL, line 32-45, col. 13) WEINMANN ET AL discloses that it is well known in the art to use epoxy resins as binders for pigment-containing coatings suitable for exterior and structural applications. (WEINMANN ET AL, line 8-18, col. 3; line 66, col. 8 to line 34, col. 9)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize known, high-durability resin binders such as alkyd resins disclosed in KADAMBAND ET AL or the epoxy resins disclosed in WEINMANN ET AL in the coating compositions of KYMINAS ET AL in order to form weather-resistant pigmented surface coatings for structural and/or exterior applications. One of ordinary skill in the art would have adjusted the amount of solids in the coating depending on the specific method of application and the coating characteristics desired for a given end-use.

6. Claims 1-2, 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over:

KADAMBANDE ET AL (US 6,627,700) or WEINMANN ET AL (US 6,395,845),  
in view of KYMINAS ET AL (US 4,749,731).

KADAMBANDE ET AL discloses coating compositions for exterior and structural applications comprising 1-90 wt% acrylate-modified alkyd resins and pigments (e.g., titanium

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dioxide, etc.). (KADAMBANDE ET AL, line 1-25, col. 11; line 32-45, col. 13) WEINMANN ET AL discloses coating compositions for exterior and structural applications comprising epoxy resins and up to 90 vol% filler (e.g. talc, etc) and up to 30 wt% additives (e.g., pigments). (WEINMANN ET AL, line 8-18, col. 3; line 66, col. 8 to line 34, col. 9) However, the references do not explicitly disclose the recited amounts of various pigments.

KYMINAS ET AL discloses that it is well known in the art to incorporate a combination of pigments into a coating composition used for exterior and structural applications, wherein the compositions typically contain 3-25 wt% titanium dioxide, 5-30 wt% talc, and 1-25 wt% calcined clay in order to obtain a highly durable protective pigmented coating for exposed surfaces. (line 50-62, col. 4; line 45-66, col. 5; line 25-38, col. 6)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize combinations of known fillers and pigments in the coating compositions of KADAMBANDE ET AL or WEINMANN ET AL in order to tailor the visual appearance, hiding power, durability, and other physical properties of the resultant coatings for specific applications. One of ordinary skill in the art would have adjusted the amount of solids in the coating depending on the specific method of application and the coating characteristics desired for a given end-use.

7. Claims 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over:  
WU (US 3,997,694) or WU (US 3,943,187).

The WU references disclose coatings suitable for direct food contact (i.e., food safe), wherein the food comprises 5-40 wt% of an epoxy resin, 1-15 wt% pigment (e.g., titanium

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dioxide), and 2-8 wt% of a filler (e.g., talc) (WU '694, line 1-8, col. 2; line 7-57, col. 4; line 10-20, col. 5, etc.) (see corresponding portions of WU '187)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a food safe coating as disclosed in the WU references to form durable protective films for food containers. One of ordinary skill in the art would have incorporated effective amounts of known non-toxic functional additives conventionally used in the coating art to enhance the performance of coating compositions (e.g., to prevent foaming, control viscosity, modify surface-tension, maintain uniform dispersion of fillers and pigments, etc.) (claims 22-25) in the compositions of the WU references in order to improve the coating characteristics of the composition and the physical properties of the resultant coating.

8. Claims 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over:

WU (US 3,997,694) or WU (US 3,943,187),

as applied to claim 21,

and further in view of CHRISTENSON ET AL (US 4,335,829).

CHRISTENSON ET AL discloses that it is well known in the art to incorporate known additives such as flow control agents, surfactants, and other formulating additives to food-grade coatings in order to enhance and modify the performance of coating compositions. (lines 35-38, col. 5).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use effective amounts of known non-toxic functional additives conventionally used in the coating art to enhance the performance of coating compositions (e.g., to prevent foaming,

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control viscosity, modify surface-tension, maintain uniform dispersion of fillers and pigments, etc.) (claims 22-25) in the compositions of the WU references in order to improve the coating characteristics of the composition and the physical properties of the resultant coating.

### ***Response to Arguments***

9. Applicant's arguments filed 8/18/2007 have been fully considered but they are not persuasive.

(A) Applicant argues that the disclosure as originally filed provides support for the coating compositions as presently recited in claim 1 which omit NILSET™ 117, HAPCO™ NXZ, and BORCHI® GOI E2. However, while the specification provides support for a coating composition which does not require these three compounds, that formulation is deemed to be distinct from the formulation(s) of claim 1, which are the formulations of type I and II (see paragraphs 0028 and 0029 in the published application). The coating compositions as recited in claim 21 and described in paragraph 0027 in the published application appears to differ from the compositions as presently recited in claim 1 on several significant points (e.g., with respect to the relative amounts of talc with respect to the amount of resin and titanium dioxide, calcined clay being an optional component or essential component, etc.).

(B) Applicant's arguments with respect to KUO '292 or KUO '453 are moot in view of the new grounds of rejection.

(C) Regarding the rejections under 35 USC 112, first paragraph, and 35 USC 112, second paragraph, based on the usage of trademarks and/or tradenames, said rejections remain outstanding because the specification as originally filed fails to provide *any* information or



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generic terminology (e.g., chemical composition, function, etc.) which would adequately identify the recited compounds to one of ordinary skill in the art. Although Applicant argues that the function and/or general composition of NILSET™ 117, HAPCO™ NXZ, and BORCHI® GOI E2 are known in the art, generalized statements in Applicant's arguments are not adequate, especially when such compounds are apparently highly region-specific. Such information should be present as objective evidence (e.g., in the form of declarations, product documentation, etc.) for the record.

### *Conclusion*

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (571) 272-1506. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho, can be reached on (571) 272-1123. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

The General Information telephone number for Technology Center 1700 is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 10, 2009

/Vivian Chen/

Primary Examiner, Art Unit 1794